




Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)
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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 1248-0674P	
	Application Number 10/681,167-Conf. #6469	Filed October 9, 2003	
	First Named Inventor Yasuaki FUKADA et al.		
	Art Unit 2854	Examiner A. H. Nguyen	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant /inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input type="checkbox"/> attorney or agent of record. Registration number _____</p> <p><input checked="" type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. <u>19,382</u></p> <p> Signature <u>Terrell C. Birch</u> Typed or printed name</p> <p><u>(703) 205-8000</u> Telephone number</p> <p><u>March 2, 2006</u> Date</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input type="checkbox"/> *Total of <u>1</u> forms are submitted.</p>			

The Examiner has made clear errors in interpreting and applying the appropriate tests and applying the prior art in rejecting claims 1-17 under 35 U.S.C. § 103(a) as being unpatentable over *Noguchi et al.* (USP 4,978,980) in view of *Yasui et al.* (USP 5,839,032).

**The Examiner has Failed to Establish Prima Facie Obviousness
by Failing to Provide References that Teach or Suggest All of the Claim Elements**

The Examiner has made clear error in stating certain claim elements are taught by an unduly broad interpretation of the teachings of the prior art.

In order to sustain a rejection under 35 U.S.C. § 103(a), it is respectfully submitted that the Examiner must meet his burden to establish a *prima facie* case. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations." *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

With regard to claim 1, the Examiner admits that *Noguchi et al.* fails to teach or suggest the intermediate roller, which is in synchronism with a resumption of rotation of the resist roller. The Examiner relies on the teachings of *Yasui et al.* to cure the deficiencies of the teachings of *Noguchi et al.* asserting *Yasui et al.* discloses intermediate roller 91 or 93 provided with a second sheet transferring path 92 for synchronizing with the rotation of the resist rollers 34a, 34b. Applicants maintain that the teachings of *Yasui et al.* are insufficient to cure the deficiencies of the teachings of *Noguchi et al.*

Claim 1 recites a two-side image forming apparatus comprising a resist roller for synchronizing a timing at which a sheet is transferred onto the first sheet-transferring path, wherein a rotation of the intermediate roller is in synchronism with a resumption of rotation of the resist roller.

First, Applicants submit note that the Examiner has failed to address the “resumption of rotation” in the outstanding rejection. The Examiner, while admitting that *Noguchi et al.* fails to teach this claim element, merely asserts that *Yasui et al.* teaches “intermediate roller 91 or 93 provided with a second sheet transferring path 92 for synchronizing with the rotation of the resist rollers 34a, 34b.” However, the Examiner fails to address the claim term “**resumption of rotation.**”

Second, *Yasui et al.* fails to provide any disclosure regarding resumption of rotation for the purported resist rollers 34a, 34b. As such, Applicants submit that *Yasui et al.* fails to cure the deficiencies of *Noguchi et al.* by failing to teach or suggest the intermediate roller, which is in synchronism with a **resumption of rotation of the resist roller**. As neither of the references, either alone or in combination, assuming these references are combinable, which Applicants do not admit, teach or suggest all of the claim elements, it is respectfully submitted that claim 1 is not obvious over the references as cited by the Examiner.

The Examiner has Failed to Establish Prima Facie Obviousness by Failing to Provide Proper Motivation to Combine the References and Relying on Impermissible Hindsight

The Examiner has made clear error in combining the teachings of the cited references without proper motivation to do so.

In order for a *prima facie* case to exist, the prior art must suggest the desirability of the claimed invention, providing motivation to make the combination proposed by the Examiner. *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ 2d 1453, 1457-58 (Fed.Cir. 1998). The level of skill in the art cannot be relied upon to provide this suggestion to combine the references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

In support of the Examiner's rejection of claim 1, the Examiner asserts one skilled in the art would be motivated to combine the teachings of *Yasui et al.* with the teachings of *Noguchi et al.* “for optimizing the print quality of two sides of a sheet.” However, neither of these references suggests this desirability as asserted by the Examiner. There is no disclosure in either of the references that suggest that

the “the intermediate roller, which is in synchronism with a resumption of rotation of the resist roller” affects print quality. As such, Applicant submits that there is no motivation to combine the references as asserted by the Examiner. Thus, the Examiner has failed to establish *prima facie* obviousness.

Further, by asserting it would have been obvious to combine the teachings of the cited references no suggestion or motivation in the applied references, the Examiner appears to rely on Applicants’ own specification for the motivation, which amounts to impermissible hindsight.

**The Examiner Seeks to Modify a Primary Reference Which
Teaches Away From the Purported Modification**

The Examiner has made clear error in combining the teachings of the cited references without considering all of the teachings of the primary reference, including those teachings that teach away from the purported modification.

The disclosure of *Noguchi et al.* is directed to a control method for a both-surface multiplex recording apparatus. One of the primary purposes of the *Noguchi et al.* apparatus is to reduce print waiting time of the recording sheets (col. 5, lines 30-35 and 57-60). *Noguchi et al.* accomplishes this by providing for an apparatus that includes two conveyance path velocities. The Examiner seeks to modify the *Noguchi et al.* apparatus by adjusting when the “resist” rollers resume rotation. However, by doing so, the speed at which the paper is being processed through the *Noguchi et al.* apparatus would be reduced. *Noguchi et al.* thus, teaches away from such a modification that would reduce the print waiting time.

**The Examiner’s Purported Combination
Changes the Principle Operation of the Primary Reference**

The Examiner has made clear error in modifying the primary reference in such a manner that would change the principle operation of the apparatus of the primary reference.

In support of the Examiner’s rejection, the Examiner seeks to modify *Noguchi et al.* to provide a two-side image forming apparatus comprising a resist roller for synchronizing a timing at which a sheet is

transferred onto the first sheet-transferring path, wherein a rotation of the intermediate roller is in synchronism with a resumption of rotation of the resist roller. However, as noted above, *Noguchi et al.* seeks to synchronize the processing of paper through the apparatus by varying the conveyance velocity.

It is well established that if the proposed modification or combination of the prior art would change the principle of operation of the prior art being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

The Examiner seeks to modify the apparatus of *Noguchi et al.* to change the principle manner in which the paper processing is synchronized. Applicants respectfully submit that by doing so, the Examiner is changing the principle operation of the *Noguchi et al.* apparatus, which is insufficient to establish *prima facie* obviousness.

**The Examiner Fails to Establish *Prima Facie* Obviousness by
Failing to Set Forth Any *Prima Facie* Rejection**

The Examiner has made clear error in failing to identify what references he is relying upon in support of his rejection of claims 6-16 and by failing to provide any motivation.

The Examiner rejected claims 6-16 under 35 U.S.C. § 103(a) as being unpatentable over *Noguchi et al.* in view of *Yasui et al.* In support of this assertion, the Examiner provides a confusing statement regarding what would be obvious with regard to only a few elements of claims 6-16 (which are not inclusive of the entire claimed invention as set forth in each of claims 6-16) However, the Examiner fails to particularly identify which of the two cited references he is relying upon to teach or suggest each of the individual elements of the claims. As such, the Examiner has failed to establish *prima facie* obviousness and, further, Applicants cannot properly respond to these rejections, as Applicants cannot ascertain which references the Examiner is relying upon to teach each of the claim elements.

In addition, with regard to the Examiner's rejection of claim 4, the Examiner appears to rely on *Noguchi et al.* to teach "a rotation of the intermediate roller is in synchronism with a resumption of

Application No. 10/681,167

rotation of the resist roller." However, this statement appears to contradict the Examiner's rejection of claim 1, wherein the Examiner relies on *Yasui et al.* to teach this claim element. As the Examiner admits that *Noguchi et al.* fails to teach or suggest this claim element, Applicants submit that the combination of the references fail to establish prima facie obviousness of the claims.

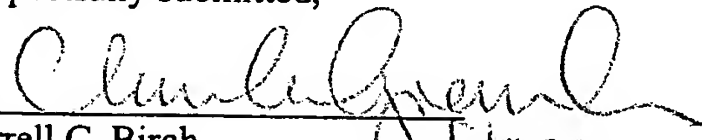
It is respectfully submitted that claims 2 -3, 5-8, and 12 are allowable for the reasons set forth above with regard claim 1 at least based upon their dependency on claim 1. It is further respectfully submitted that claims 4 and 17 contain elements similar to those discussed above with regard to claim 1 and thus claims 4 and 17, together with claims dependent thereon, are not obvious for the reasons set forth above with regard to claim 1.

Conclusion

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: March 2, 2006

Respectfully submitted,

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